

REMARKS

In the Office Action, the Examiner rejected claims 1-4, 10, 11, 16, 17, and 23-24. By this paper, Applicants have amended claims 11, 17, 27, and 33 for clarification of certain features to expedite allowance of the present application. These amendments do not add any new matter. Upon entry of these amendments, claims 1-4, 10, 11, 16, 17, and 23-24 remain pending in the present application and are believed to be in condition for allowance. In view of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

Claim Objections

In the Office Action, the Examiner objected to claims 11, 17, and 27. Specifically, the Examiner stated:

In Claim 11, it is viewed that the phrase --the rail assembly-- should be inserted before "comprising" since the remaining limitations i.e., rail members, locking mechanism for example, are specific to the "rail assembly" as opposed to the "slide assembly" [both of which are recited in the line preceding the "comprising" term. Appropriate correction is required. In Claims 17 & 27, it is recommended that the term --further-- be inserted before "comprising" since each claim introduces new limitations. Page 2, lines 3-9.

Although Applicants do not necessarily agree with the Examiner's objections, Applicants have amended the claims as set forth above. In view of these amendments, Applicants respectfully request that the Examiner withdraw the objections to claims 11, 17, and 27.

Claim Rejections under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claim 33 under U.S.C. § 112, Second Paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner stated:

Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrases “the second slide rail” & “the first and second rails” do not have a proper antecedent basis. Page 2, lines 14-17.

Because the Examiner is correct that the phrases “the second slide rail” & “the first and second rails” lack proper antecedent basis, Applicants have amended claim 33, as set forth above, to correct this minor editorial mistake. No new matter has been added to this claim. In view of this amendment, Applicants respectfully request the Examiner withdraw the rejection to the claim 33.

Claim Rejections under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 11 and 29 under 35 U.S.C. § 102(b) as anticipated by Klakovich (U.S. Patent No. 3,133,768); claims 11, 16, 27-30, 32 and 34 under 35 U.S.C. § 102(b) as anticipated by Abbott (U.S. Patent No. 6,230,903); and claims 30-33 under 35 U.S.C. § 102(b) as anticipated by Hubbard et al. (U.S. Patent No. 5,586,817). Applicants respectfully traverse these rejections.

Legal Precedent

Anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete*

detail as contained in the ... claim” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Rejections to Claims 11 and 29 based on Klakovich

Turning now to claims 11 and 29, independent claim 11, as amended, recites, among other things, a sliding track assembly comprising “a non-threaded locking mechanism.”

Detailed Rejection

In the Office Action, the Examiner specifically stated:

Klakovich (figures 1-16) teaches of a track assembly adapted to be mounted in a rack, the sliding track assembly having a slide assembly (26, 27 e.g.,) mounted to a rail assembly (elements of 22 e.g.,), the rail assembly comprising: first (25) and second (29) rail members engaged with one another expandably, the first and second rail members each having a distal end (inner-most ends) located proximate to the rack; mounting brackets (slotted flanges on each rail member) attached to distal ends of the first and second rail members; and a locking mechanism (44 & 46) interacting with the first and second rail members, the locking mechanism having a locked configuration limiting collapsing movement of the rail members with respect to one another.

Page 2, line 27 - page 3, line 9. .

Deficiencies of the Rejection

Applicants respectfully assert that claim 11, as amended, is not disclosed by the Klakovich reference. Specifically, the Klakovich reference does not teach or suggest a “non-threaded locking mechanism,” as recited by independent claim 11. In contrast, fasteners 46 in the Klakovich reference are clearly threaded fasteners. *See* Fig. 2 and col. 3, lines 29-31. In view of this deficiency, the cited reference cannot anticipate independent claim 11 and its dependent claims.

Rejections to Claims 11, 16, and 27-29 based on Abbott

As stated above, independent claim 11, as amended, recites, among other things, a sliding track assembly comprising “first and second rail members *engaged* with one another *expandably*.”

Detailed Rejection

In the Office Action, the Examiner specifically stated:

Claims 11, 16, 27-30, 32 & 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Abbott [U.S. Patent No. 6,230,903]. Abbott (figures 1-5) teaches of a track assembly adapted to be mounted in a rack, the sliding track assembly having a slide assembly (21 e.g.,) mounted to a rail assembly (elements of 27, 47 e.g.,), the rail assembly comprising: first (47) and second (27) rail members engaged with one another expandably via the slide assembly, the first and second rail members each having a distal end (inner-most ends) located proximate to the rack; mounting brackets (55, 35 respectively) attached to distal ends of the first and second rail members; and a locking mechanism (29, 31, 49 & 51 for example) interacting with the first and second rail members, the locking mechanism having a locked configuration limiting collapsing movement of the rail members with respect to one another. Each mounting bracket including a mounting tab (37) adapted to be received in a slot in the rack. The assembly further including a biasing member / spring (59) configured to expand the first and second members with respect to one another. Page 3, lines 11-24.

Deficiencies of the Rejection

The Examiner has based the section 102(b) rejection of claims 11, 16, and 27-29 on several incorrect assumptions about the Abbott reference. First, the Examiner stated in the Office Action that first mounting bracket 27 and second mounting bracket 47 of Abbott are equivalent to the first and second rail members recited in independent claim

11. Page 3, lines 14-15. Applicants stress that these brackets 27 and 47 are not rails, and one skilled in the art would not interpret brackets to be equivalent to rails. *See* Abbott, col. 3, lines 50-61. Second, these two mounting brackets 27 and 47 are clearly not “engaged with one another expandably,” as recited in claim 11, because *they are not even connected*. *See* Fig. 2. Third, the Abbott reference provides a knob 49 that is “tightened to fixedly secure the second mounting bracket 49,” and not a non-threaded locking mechanism, as recited in independent claim 11. Col. 4, lines 21-22. For these reasons alone, Applicants respectfully request withdrawal of the Examiner’s rejection of independent claim 11 and the claims that depend therefrom.

Rejections to Claims 30, 32, and 34 based on Abbott

Among other things, independent claim 30 recites “a first rail member configured to receive a second rail member *expandably*.”

Detailed Rejection

The Examiners’ rejection of claims 30, 32, and 34 based on Abbott is reproduced above in regard to claims 11, 16, and 27-29.

Deficiencies of the Rejection

The Examiner’s rejection is flawed for a number of reasons. The Abbott reference does not anticipate “a first rail member configured to receive a second rail member *expandably*,” as recited by independent claim 30. In sharp contrast, brackets 27 and 47, which were cited by the Examiner to be equivalent to the first rail member and the second rail member recited in the claims, are not even in contact with one another. *See* Fig. 2. Therefore, the brackets 27 and 47 do not *receive* one another as recited in claim 30. For this reason alone, the Abbott reference cannot anticipate “a first rail member configured to receive a second rail member *expandably*,” as recited in independent claim 30.

Rejections to Claims 30-33 based on Hubbard

Among other things, independent claim 30 recites “a first rail member configured to *receive* a second rail member *expandably*,” and “a locking mechanism configured to *prevent relative movement* between the distal ends.”

Detailed Rejection

In the Office Action, the Examiner specifically stated:

Claims 30-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Hubbard et al., [U.S. Patent No. 5,586,817]. Hubbard (figures 1-2) teaches of a track assembly comprising: a first rail member (60) configured to receive a second rail member (46) rail expandably, wherein the first and second rail members each include an engaged end (64, 50) located proximate to cooperating portions of the rail members, and a distal end located opposite the engaged end; a biasing member/compression spring (82) configured to bias the distal ends relative to one another; and a locking mechanism (70, 54 for example) configured to prevent relative movement between the distal ends (as viewed when element 70 is at either of the two most extreme positions with element 54). The locking mechanism is viewed as being “tool-lessly” operable in the sense that the mechanism needs no tools to operate. The locking mechanism comprising a tab (viewed as the elongated “tab portion” on end 52) located on the second rail and an actuable member (70) extending through both rail members for interlocking engagement with the tab via (54). Page 4, lines 3-16.

Deficiencies of the Rejection

First, the Hubbard reference does not teach or suggest “a first *rail member* configured to receive a second *rail member* expandably,” as recited by independent claim 30. (emphasis added). Again, Applicants stress that the first link mechanism 46 and a second link mechanism 60 described in the Hubbard reference, which were cited by the

Examiner, are clearly not rail members. In contrast, they are—as their name implies—link mechanisms that comprise an “interlock mechanism ... to prevent simultaneous extension of more than one” of two drawers. Abstract, lines 1-3. For this reason, the Hubbard reference cannot anticipate “a first rail member configured to receive a second rail member expandably,” as recited in independent claim 30.

Second, the Hubbard reference does not teach or suggest “a first rail member configured *to receive a second rail member expandably*,” as recited by independent claim 30. (emphasis added). On the contrary, the Hubbard reference discloses that the first and second link mechanisms 46 and 60 are pivotably mounted together at single point via a screw 80. Col. 2, lines 27-28. In other words, the pivotal coupling at screw 80 only permits rotational movement, thereby precluding any linear movement of the first and second link mechanisms 46 and 60 at the single point of the screw 80. Moreover, the first and second link mechanisms 46 and 60 do not *receive* one another, but rather they are independently joined by the screw 80. For these reasons, the second link mechanism 60 cannot be configured to receive the first link mechanism 47 *expandably* as the Examiner suggested. In view of these deficiencies, the cited reference cannot anticipate independent claim 30 and its dependent claims.

Third, the Hubbard reference does not disclose “a locking mechanism configured to prevent relative movement between the distal ends,” as recited in independent claim 30. In sharp contrast, the slot 54 and shaft 70 disclosed in the Hubbard reference are actually designed *to allow relative movement* between the rollers 56 and 76. *See* col. 2, lines 17-34. Otherwise, rollers 56 and 76 would not be capable of moving into the sloped surface 37 of the notch 34 in the drawer 10. *See id.* For this reason, the Hubbard reference absolutely fails to anticipate “a locking mechanism configured to prevent relative movement between the distal ends,” as recited in claim 30.

For the reasons discussed above, Applicants respectfully request withdrawal of all of the rejections under 35 U.S.C. § 102.

Claim Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claim 16 under 35 U.S.C. § 103(a) as obvious over Klakovich (U.S. Patent No. 3,133,768) in view of Abbott (U.S. Patent No. 6,230,903).

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide *objective evidence*, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, a statement that the proposed modification would have been 'well within the ordinary skill of the art' based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d.

1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999).

Detailed Rejection

As stated above, the Examiner rejected dependent claim 16 based on the Klakovich reference in view of the Abbott reference. Specifically, the Examiner stated:

Klakovich teaches applicants inventive claimed structure as disclosed above, but does not show the brackets having a mounting tab(s) so as to be received in a slot on the rack. However, Abbott teaches the known use of employing mounting tabs (37) on mounting brackets (35, 55) in an analogous art. As such, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the brackets of Klakovich so as to incorporate tabs as taught by Abbott because this arrangement would provide Klakovich with a positive seating connection between the brackets and the rails of the rack since the tabs would be "seated" within the mounting apertures as opposed to being loosely aligned and then secured. Page 4, line 28 – page 5, line 9.

Deficiencies of the Rejection

Claim 16 depends on independent claim 11, and as described above, neither the Klakovich reference nor the Abbott reference anticipates independent claim 11. First, Klakovich fails to teach or suggest a non-threaded locking mechanism, as recited in claim 11. Second, Abbott provides a knob 49 that is "tightened to fixedly secure the second mounting bracket 49," and not a non-threaded locking mechanism, as recited in independent claim 11. Col. 4, lines 21-22. Third, Abbott fails to anticipate "first and second rail members *engaged* with one another *expandably*," as recited by independent claim 11. As such, these elements will be missing from a combination of the two references. For these reasons alone, Applicants respectfully request the Examiner withdraw the rejection under section 103(a).

In addition, the Examiner has not shown the requisite motivation or suggestion to modify or combine the cited references to reach the present claims. As summarized above, the Examiner must provide *objective evidence*, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). In the present rejection, the Examiner combined the cited references based on the *conclusory and subjective statement* that it would have been obvious “to a person of ordinary skill in art at the time the invention was made to modify the brackets of Klakovich so as to incorporate tabs as taught by Abbott because this arrangement would provide Klakovich with a positive seating connection between the brackets and the rails of the rack.” Page 5, lines 4-7. This is simply not objective evidence. Accordingly, Applicants respectfully request that the Examiner to produce *objective evidence* of the requisite motivation or suggestion to combine the cited references, or remove the foregoing rejection under 35 U.S.C. § 103.

For these reasons, Applicants respectfully request withdrawal of the Examiner’s rejections under 35 U.S.C. § 103.

Claim Rejections under Doctrine of Obviousness-Type Double Patenting

In the Office Action, the Examiner rejected claims 1, 3, 4, 11, 17 and 23-34 under the judicially created doctrine of obviousness-type double patenting based on claims 1-9 of U.S. Patent No. 6,702,412, issued on the parent application. Although Applicants do not agree that the present claims 1, 4, 11, 17 and 23-34 are obvious over claims 1-9 U.S. Patent No. 6,702,412, issued on the parent application, Applicants are willing to file a terminal disclaimer if necessary when the claims are indicated as allowable.

In the Office Action, the Examiner rejected claims 2, 10, and 16 under the judicially created doctrine of obviousness-type double patenting based on “claims 1-9 of

U.S. Patent No. 6,230,903 in view of Abbott.” Page 6, lines 10-11. Applicants respectfully point out to the Examiner that U.S. Patent No. 6,230,903 is, in fact, the Abbott patent. If the Examiner meant to base this rejection on claims 1-9 of U.S. Patent No. 6,702,412, issued on the parent application, although Applicants do not agree that the present claims 2, 10, and 16 are obvious over claims 1-9 of U.S. Patent No. 6,702,412, in view of Abbott, Applicants are willing to file a terminal disclaimer if necessary when the claims are indicated as allowable.

In the Office Action, the Examiner also rejected claim 3 under the judicially created doctrine of obviousness-type double patenting based on “claims 1-9 of U.S. Patent No. 6,230,903 in view of Reddicliffe.” Page 6, lines 22-24. Again, Applicants respectfully point out to the Examiner that U.S. Patent No. 6,230,903 is the Abbott patent. If the Examiner meant the rejection to be based on claims 1-9 of U.S. Patent No. 6,702,412, although Applicants do not agree that the present claim 3 is obvious over claims 1-9 of U.S. Patent No. 6,702,412 in view of Reddicliffe, Applicants are willing to file a terminal disclaimer if necessary when the claims are indicated as allowable.

Conclusion

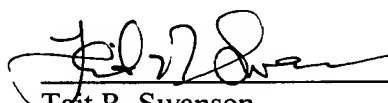
Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes a telephone conference would expedite further prosecution, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Authorization to Debit Deposit Account

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136 (a), and any fees required therefore (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 08-2025.

Respectfully submitted,

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